

REMARKS

This communication is in response to the Office Action mailed July 3, 2002.

Restriction Requirement

Applicants acknowledge that the Examiner has removed the restriction requirement as between claims 1-8 and claims 9-15, and maintained the restriction as between claims 1-15 and claims 16-30. Applicants herein cancel claims 16-30 without prejudice as they are non-elected claims and the restriction requirement has been made final.

Rejection under 35 USC 102(b)

In the Office Action, the Examiner rejected claims 1, 3-4, 7, 9 and 12-14 under 35 USC 102(b) as being anticipated by Katsuyuki (JP 58-169149). Applicants respectfully traverse the rejection. In order to be a proper rejection under 35 USC 102, the reference relied upon has to teach each and every element of the claim. Katsuyuki does not teach or suggest each and every element of the claims under rejection. For example, Katsuyuki does not teach a *semiconductor wafer* having a region which includes magnetic means for identification as recited in independent claims 1 and 9. Rather, Katsuyuki discloses a magnetic film 3 formed on the surface of a substrate, wherein the substrate is a *glass* substrate used to make a photomask. Although a photomask is used in the fabrication of semiconductor devices, a photomask itself is not a semiconductor substrate. Accordingly, Katsuyuki does not disclose Applicants' claimed invention, and the rejection of claims 1 and 9, and each the dependencies of claims 3-4, 7, and 12-14, is improper. Withdrawal of the rejection is therefore respectfully requested.

Rejection under 35 USC 103(a) -claims 6 and 15

In the same Office Action the Examiner rejected claims 6 and 15 under 35 USC 103(a) as being unpatentable over Katsuyuki in view of Chang (US006197481B1) and Oishi (US006004405A). Applicants also respectfully disagree with this rejection. The Examiner relies upon Chang and Oishi to show that it is known to form a film over alignment or identification marks of a semiconductor wafer. Regardless of the validity of this proof (which Applicants do not concede), the Examiner has failed to show that it is known to form magnetic identification marks on a semiconductor wafer. And therefore the basis of the rejection is improper (see discussion above) and withdrawal is respectfully requested.

Rejection under 35 USC 103(a) - claim 8

The Examiner also rejected claim 8 under 35 USC 103(a) as being unpatentable over Katsuyuki in view of Oishi. Claim 8 recites that the magnetic means is placed at an inner region of the semiconductor wafer surface. The Examiner relies upon Oishi to show that choice of the location of a mark is chosen where it will not interfere with the effective area of the wafer, which in Oishi is around the wafer periphery. The Examiner attempts to extend this teaching to say that an area where a vacuum chuck is employed may be used as a mark area since it is "not an affective area, but a peripheral area." Applicants respectfully disagree with the rejection. Claim 8 expressly recites that the magnetic means are at an "inner region", which is in contrast to a peripheral or edge region (see page 6, lines 12-22). Thus, the inner region of Applicant's claim 8 is not a peripheral or edge exclusion region and thus is not suggested of Oishi. Moreover, Katsuyuki fails to disclose or suggest a magnetic means for identification of a *semiconductor wafer* as stated previously. Thus the rejection of claim 8 by the combination of Katsuyuki and Oishi fails to disclose or suggest each of the claim elements and limitations of claim 8 as presently recited, and withdrawal of the rejection of this claim is therefore respectfully requested.

Allowable Subject Matter

Applicants acknowledge that the Examiner has indicated that claims 2 and 10 contain patentable subject matter if rewritten to be independent form. However, amendments of these claims are not being made at this time, pending further review of independent claims 1 and 9 based on the arguments presented herein.

Close

Applicants respectfully submit that the claims as recited herein are readily distinguishable from the prior art and contain patentable subject matter. Such allowance of these claims is therefore respectfully requested. Should the Examiner have any questions concerning this response or the application generally, s/he is invited to contact Applicants' attorney or agent as identified below.

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Motorola, Inc.
Law Department

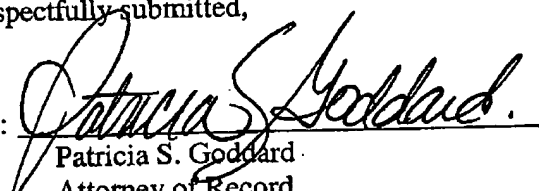
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